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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,427	04/05/2005	Robert Zhong Lu	102792-433 (11136P3)	6698
27389	7590	03/08/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			DELCOTTO, GREGORY R	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/530,427

Applicant(s)

LU, ROBERT ZHONG

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-15, 19-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15, 21-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6, 8-15, 19-23 and 25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-05</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 1-6, 8-15, 19-23, and 25 are pending. Claims 7, 16-18, and 24 have been canceled. The preliminary amendment filed 4/5/05 has been entered.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 8-15, 21-23, and 25, drawn to an aqueous hard surface cleaning composition.

Group II, claim(s) 19 and 20, drawn to a process for the sanitization of hard surfaces.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1, at least, is anticipated by or obvious over Charlez et al (US 6,001,795). Consequently, the special technical feature which links claims 1-6, 8-15, 19-23, and 25, an aqueous hard surface cleaning composition, does not provide a contribution over the prior art, so unity of invention is lacking.

During a telephone conversation with Andrew Parfomak on February 15, 2006, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 8-15, 21-23, and 25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19 and 20 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claims 10-15 objected to because of the following informalities:

With respect to claim 10, it appears that the word "further" should be deleted.

Appropriate correction is required. Note that, claims 11-15 have also been rejected due to their dependency on claim 10.

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. With respect to instant claim 4, it fails to limit claim 1 in that claim 1 requires the presence of a soap and claim 4 recites that the soap may be present in an amount of "0%" by weight.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Charlez et al (US 6,001,795).

Charlez et al teach a microemulsion composition which is especially effective in the removal of oily and greasy soil which contains an anionic detergent, a saturated fatty acid, an unsaturated fatty acid, a solubilizing agent, a perfume having pine like odor, an alkali metal hydroxide, and water. See Abstract. The composition is suitable for cleaning hard surfaces such as plastic, vitreous and metal surfaces having a shiny finish. Also, the compositions exhibit a blooming effect when the composition is added to water in that the formed solution is cloudy. See column 3, lines 10-25. Suitable co-surfactants include ethylene glycol monobutyl ether, propylene glycol monomethyl ether, propylene glycol monoethyl ether, propylene glycol monobutyl ether, etc. See column 8, lines 1-45. Additionally, pH adjusting agents such as sodium hydroxide may be used in amounts up to 4% by weight. See column 10, lines 5-30.

Specifically, Charlez et al teach a composition containing 2.17% sodium dodecyl benzene sulfonate, 2% stearic acid, 2.3% coconut fatty acid, 2.0% isopropanol, 2.5% diethylene glycol monobutyl ether, 2.7% potassium hydroxide, 5% perfume and the balance water. See column 11, lines 20-50. Charlez et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Charlez et al anticipate the material limitations of the instant claims.

Claims 1-6, 8-11, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Evers (US 2002/0069901).

Evers teaches a process of cleaning a hard surface with a liquid neutral to alkali composition comprising a polymer and a surfactant system wherein said surfactant

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system comprises a sulphated or sulphonated anionic surfactant, a neutralizing co-surfactant and an alkoxylated nonionic surfactant. See Abstract. The composition may also comprise up to 2% by weight of a fatty acid. See claims 11-13. Preferred fatty acids include coconut fatty acid. See paras. 143-149. Preferred solvents include benzyl alcohol, ethanol, methanol, etc. See paras. 166. Additionally, the compositions may include perfumes. See paras. 170-175.

Specifically, Evers teaches compositions containing 0.31% sodium paraffin sulphonate, 0.5% sodium hydroxide, 4% butoxy propanol, water, etc. See paras. 228-230. Evers discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Evers anticipate the material limitations of the instant claims.

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 478,086.

'086 teaches low viscosity and high pH disinfecting and bleaching all purpose cleaning compositions in microemulsion form, suitable in both concentrated and diluted forms. See Abstract. Specifically, '086 teaches a composition containing 1% sodium C12-C18 alkyl sulfate, 0.5% coco fatty acid, 0.5% potassium hydroxide, 5% tertiary butanol, 0.3% perfume, 8% aqueous sodium hypochlorite, water, etc. '086 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '086 anticipate the material limitations of the instant claims.

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Claims 1-6, 8-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO94/14945. Note that, a translation of this document has been requested.

'945 teaches water-based cleaning agents having a pH between 5 and 9 containing 1 to 25% by weight of nonionic or anionic surfactant, 0.1 to 12% by weight of benzyl alcohol, 2-phenoxyethanol, or 2-phenylethanol. See Abstract.

Specifically, '945 teaches a cleaning composition containing 0.05% sodium hydroxide, 0.8% benzene sulfonate, 0.4% coco-fatty acid, , 0.3% perfume, 2% phenoxyethanol, water, etc. See page 12, lines 1-15 and page 10, lines 1-15. '945 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '945 anticipate the material limitations of the instant claims.

Claims 9-11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charlez et al (US 6,001,795).

Charlez et al are relied upon as set forth above. However, Charlez et al do not teach, with sufficient specificity, a composition containing an alkali metal hydroxide in addition to the other requisite components of the composition in the specific amounts as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing an alkali metal hydroxide in addition to the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because the



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broad teachings of Charlez et al suggest a composition containing an alkali metal hydroxide in addition to the other requisite components of the composition in the specific amounts as recited by the instant claims.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evers (US 2002/0069901).

Evers is relied upon as set forth above. However, Evers does not teach, with sufficient specificity, a composition containing benzyl alcohol in addition to the other requisite components of the composition in the specific amounts as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing benzyl alcohol in addition to the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Charlez et al suggest a composition containing benzyl alcohol in addition to the other requisite components of the composition in the specific amounts as recited by the instant claims.

Claims 21-23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Evers (US 2002/0069901), EP 478,086, or WO94/14945.

Evers, '086, or '945 are relied upon as set forth above. Note that, the Examiner asserts that the compositions as specifically disclosed by Evers, '086, or '945 would inherently have the same disinfectant and blooming characteristics as recited by the

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instant claims because the compositions as specifically disclosed by Evers, '086, or '945 contain the same components in the same amounts as recited by the instant claims. Evers, '086, or '945 disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Evers, '086, or '945 anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Evers, '086, or '945 are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed disinfectant and blooming properties of the composition in order to provide the optimum disinfectant and cleaning properties to the composition because Evers, '086, or '945 teach that the amount of required components added to the composition may be varied.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charlez et al (US 6,001,795) as applied to claims 1-6, 8-11, 13, 15 and 25 above, and further in view of Evers (US 2002/0069901).

Charlez et al are relied upon as set forth above. However, Charlez et al do not teach the use of benzyl alcohol in addition to the other requisite components of the composition as recited by the instant claims.

Evers is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use benzyl alcohol in the cleaning composition taught by Charlez et al, with a reasonable expectation of success, because Evers teaches the

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equivalence of benzyl alcohol to propylene glycol monobutyl ether in a similar cleaning composition and further, Charlez et al teach the use of propylene glycol monobutyl ether.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charlez et al (US 6,001,795) or Evers (US 2002/0069901) as applied to the rejected claims above, and further in view of WO00/49127 or Harrison et al (US 2002/0119902).

Charlez et al or Evers are relied upon as set forth above. However, neither reference teaches the use of propylene glycol phenyl ether in addition to the other requisite components of the composition as recited by the instant claims.

Harrison et al teach aqueous-based cleaning compositions simultaneously featuring disinfecting, low residue deposits and good cleaning characteristics which are particularly useful for cleaning glass and polished hard surfaces. See Abstract. The compositions contain an alkylene glycol solvent such as propylene glycol isobutyl ether, ethylene glycol butyl ether, propylene glycol phenol ether, etc. See para. 34.

'127 teaches hard surface cleaning and disinfecting compositions containing a synergistic combination of a quaternary ammonium compound and an alkoxyated quaternary ammonium compound. See Abstract. Suitable solvents include propylene glycol isobutyl ether, ethylene glycol butyl ether, propylene glycol phenyl ether, etc. See page 24, lines 1-20.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a solvent such as propylene glycol phenyl ether in the compositions taught by Charlez et al or Evers, with a reasonable expectation of

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success, because Harrison et al or '127 teach the equivalence of propylene glycol butyl ether to propylene glycol phenyl ether in a similar cleaning composition and further, Charlez et al or Evers teach the use of propylene glycol butyl ether.

Claims 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Charlez et al (US 6,001,795).

Charlez et al are relied upon as set forth above. Note that, the Examiner asserts that the composition as specifically disclosed by Charlez et al would inherently have the same disinfectant characteristics as recited by the instant claims because the composition as specifically disclosed by Charlez et al contain the same components in the same amounts as recited by the instant claims. Charlez et al discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Charlez et al anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Charlez et al are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed disinfectant properties of the composition in order to provide the optimum disinfectant and cleaning properties to the composition because Charlez et al teach that the amount of required components added to the composition may be varied.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8-15, 21-23, and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15, 16, 29, and 31 of copending Application No. 10/530433, claims 1-20 of 10/530372, and claims 1-5, 10-21, 24, and 25 of 10/530926. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12, 15, 16, 29, and 31 of copending Application No. 10/530433, claims 1-20 of 10/530372, and claims 1-5, 10-21, 24, and 25 of 10/530926 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition, having the specific disinfectant and blooming properties, containing an anionic surfactant, alkali metal hydroxide, soap, solvent, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, because claims 1-12, 15, 16, 29, and 31 of

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copending Application No. 10/530433, claims 1-20 of 10/530372, and claims 1-5, 10-21, 24, and 25 of 10/530926 suggest a composition, having the specific disinfectant and blooming properties, containing an anionic surfactant, alkali metal hydroxide, soap, solvent, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.


Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory R. Del Cotto  
Primary Examiner  
Art Unit 1751

GRD  
March 4, 2006